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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,546	09/14/2005	Martine Barth	11123.0101USWO	1427
	7590 02/13/2007		EXAMINER	
MERCHANT & P.O. BOX 2903			EXAMINER MURRAY, JEEFREY H ART UNIT PAPER NUMBER 1609 DELIVERY MODE	EEFREY H
MINNEAPOLI	S, MN 55402-0903		ART UNIT	PAPER NUMBER
	•		1609	
SHORTENED STATUTOR	Y PERIOD OF RESPONSE	MAIL DATE	DELIVER	Y MODE
31 D	AYS	02/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)				
	10/549,546	BARTH ET AL.				
Office Action Summary	Examiner	Art Unit				
	Jeffrey H. Murray	1609				
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet w	ith the correspondence address				
A SHORTENED STATUTORY PERIOD FOR REPL' WHICHEVER IS LONGER, FROM THE MAILING D. Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNI 36(a). In no event, however, may a will apply and will expire SIX (6) MOI e, cause the application to become A	CATION. reply be timely filed NTHS from the mailing date of this communication BANDONED (35 U.S.C. § 133).				
Status						
1)⊠ Responsive to communication(s) filed on 09/14	<i>4/2005</i> .					
	action is non-final.					
, <u> </u>	/ _					
closed in accordance with the practice under E	•		,			
Disposition of Claims						
4) Claim(s) <u>1-9</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdraw	wn from consideration.					
5) Claim(s) is/are allowed.						
6) Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.	7) Claim(s) is/are objected to.					
8) Claim(s) <u>1-9</u> are subject to restriction and/or el	lection requirement.					
Application Papers						
9)☐ The specification is objected to by the Examine	er.					
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) ☐ The oath or declaration is objected to by the Ex	caminer. Note the attache	d Office Action or form PTO-152.				
Priority under 35 U.S.C. § 119						
 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority document application from the International Bureau * See the attached detailed Office action for a list 	s have been received. s have been received in A rity documents have beer u (PCT Rule 17.2(a)).	Application No received in this National Stage				
Attachment(s) 1) Notice of References Cited (PTO-892)	4) 🔲 Interview	Summary (PTO-413)				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	Paper No(s)/Mail Date nformal Patent Application				

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. The compound or composition of formula I, according to Claims 1-3, 7, wherein p is 2, X is CH and Y is -CH₂CH₂OCH₂-.
- II. The compound or composition of formula I, according to Claims 1-3, 7, wherein p is 2, X is N and Y is -CH₂CH₂OCH₂-.
- III. The compound or composition of formula I, according to Claims 1-3, 7, not previously covered under Groups I-II.
- IV-VI. The method of preparing a compound or composition of formula I, according to Claims 4-6, wherein the compound or composition prepared is from Group I-III respectively.
- VII-IX. The method of using a compound or composition of formula I, according to Claims 8-9, wherein the compound or composition is from Group I-III respectively.

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- 2. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: There is prior art associated with some of the various cores of the formula I compounds or compositions. There is also no common core associated with the compounds or compositions associated with Groups I-IX. The international application shall relate to one invention only or to a group of inventions so linked as to form a general inventive concept under PCT Rule 13. The main features of the formula I core contain an aryl sulfonamide with a minimum C₂ alyklene linker, followed by a carbonyl and 6- or 7membered ring containing one or two nitrogens. The technical features claimed within these compounds and compositions are not a contribution over the prior art and thus the inventions of Groups I-IX lack unity. For example, WO 9807697 and WO 9610022 contain similar compounds showing that these main cores are well known in the art. Furthermore, a common core is also an important aspect in defining a single general inventive concept. Groups I-IX follow the general formula I, however, the formula is broad between each of the nine Groups due to the ability of the compound or composition to contain a 6-membered or 7-membered ring which may contain one or two nitrogens within each individual Group so as not to have a common core. For the reasons mentioned above, this case is being restricted.
- 3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected

process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Various compounds and compositions selected from the Markush groups that appear in Claim 1.

The species listed above do not relate to a single general inventive concept under PCT 5. Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: prior art WO 9807697 and WO 9610022 was found showing common core structures already exist and multiple cores structures listed within Claim 1.

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Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

- 7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
- 8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on M-F 7:30-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Andrew Wang can be reached on 571-272-0811 or Cecilia Tsang can be reached at 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Jeffrey H. Murray

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ANDREW WANG

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